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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/009,052 | 12/06/2001 | Monica Bokstrom | B&LAB-009 | 4387 |
| 7590 07/25/2005 | | | EXAMINER | |
| Lerner David Littenberg Krumholz & Mentlik 600 South Avenue West Westfield, NJ 07090 | | | LOPEZ, CARLOS N | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1731 | |
| DATE MAILED: 07/25/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|---|-----------------|-----------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. | Applicant(s) | |
| | 10/009,052 | BOKSTROM ET AL. | |
| | Examiner | Art Unit | |
| | Carlos Lopez | 1731 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 June 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): 112 1st paragraph rejection of claim 23.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 22 and 23.

Claim(s) objected to: _____.

Claim(s) rejected: 17-21.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

[Handwritten signature]

Continuation of 11. does NOT place the application in condition for allowance because:
Applicant's arguments filed 6/20/05 have been fully considered but they are not persuasive.

Applicant's argument in regards to the 35 USC 112 1st paragraph rejection of claims 17-21 is found unpersuasive. Applicant argues that the specification supports the claimed limitation of passing pulp "that does not form a gas sealing plug." However, the specification does not explicit disclose or imply excluding the formation of a gas sealing plug.

As noted in MPEP 2173.05(i), any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Applicant also argues that the limitation "outlet pipe directly communicates with the interior of the reaction vessel" excludes an intermediate fluffing step. It is noted that a limitation of an outlet pipe directly communicating with the interior of the reaction vessel does not explicitly claim the argued limitation of excluding a fluffing step. Furthermore, the claims do not exclude a fluffing step as argued by applicant in Applicant's response page 9-second paragraph. The claimed limitation of having the pipe directly communicating with the reaction vessel only requires the pipe to open into the reaction vessel; it does not exclude the pipe from having additional features that are within the pipe.

Applicant also argues that the pressure regulation device regulates the gas pressure during operation in the pulp shredding vessel and the gas pressure in the reaction vessel to prevent leakage of ozone gas upstream through the outlet pipe into the pulp-shredding vessel. However, it is noted that claim 17 only requires a device that is capable of regulating the gas pressure. Hence the fact that the device of '365 is in operation during a system shutdown as opposed to during operation does not structurally distinguish a system for treating pulp derived from the combined teachings of '365 and '040. Applicant's arguments are based on patentably distinguishing the claimed apparatus based on its functionality as opposed to the required structural distinction. In fact '365 in page 6, lines 6-9, clearly discloses that the pressure regulation device can be used as an integral part of the system if it is warranted to use a shorter length conveyor 16 that does not provide for a pulp plug having sufficient length to prevent gas leakage through the conveyor. Thus showing that the pressure device indeed can be used during operation if a short length conveyor is used.

In response to applicant's argument presented in page 12 lines 6-15, applicant is referred to page 5 lines 5-12 of '365 explicitly disclosing pulp subjected to minimal compaction or elimination of compaction forces.

In regards to the argument that the '365 requires a gas sealing plug as argued in page 12 8th to last line, applicant is again referred to page 5 lines 5-12 of '365 teaching that the plug is a porous plug. Hence the plug per se can't be considered a gas-sealing plug since it is porous. It is agreed that '365 uses a plug to serve as a gas sealing but as noted by '365 in lines 5-7 page 4, the plug can't be considered a "gas sealing plug" per se because it allows for the gas to pass through the conveyor thus requiring the claimed pressure regulating device. Additionally, the fact that '365 use of a screw conveyor 16 does not imply that the plug is a gas-sealing plug. In fact in arguing that the use of a screw conveyor somehow renders the plug to be a gas sealed plug would be undermining applicant's own invention since '365 like applicant's invention uses a conveyor plug 24,26.

In regards to the argument presented in page 13 lines 10-25, Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Finally, Applicant's argues that the breaker bars 40 provide some compression to the pulp in the last paragraph of page 13. The instant claim only requires transport means adapted to transport the pulp out of the shredder without compression for which transport screw 16 having core 24 and threads 26 were deemed as the claimed transport means. This directly corresponds to alternative embodiment of '365 having a transport means with no breaker arms 40 as shown in figure 1. Thus, applicant is arguing an alternative embodiment of '365, as depicted in figure 2, that does not read and is inapplicable to applicant's claimed invention.

It is also noted that applicant's amendment to claim 23 obviates the 35 USC 112 1st paragraph rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is 571.272.1193. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571.272.1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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